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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/847,134 | 05/02/2001 | Timothy J. Hoffman | 0994.00131 | 8994 |

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01/29/2003

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EXAMINER

JONES, DAMERON LEVEST

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/847,134

Applicant(s)

HOFFMAN ET AL.

Examiner

D. L. Jones

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2002 and 18 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 53-61 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 14, 37 and 46 is/are rejected.
- 7) ☒ Claim(s) 3-13, 15-36, 38-45 and 47-52 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) g.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

ACKNOWLEDGMENTS

1. The Examiner acknowledges receipt of Paper No. 9, filed 10/18/02, wherein claims 1, 14, 37, and 53 were amended.

Note: Claims 1-61 are pending.

RESPONSE TO APPLICANT'S ARGUMENTS/AMENDMENTS

2. The Applicant's arguments filed 10/18/02 (Paper No. 9) to the rejection of claims 1-61 made by the Examiner under 35 USC 103, 112, and/or double patenting have been fully considered and deemed persuasive-in-part for the reasons set forth below.

112 Rejections

The 112 rejects are WITHDRAWN for reasons of record in Applicant's response.

103 Rejection

The 103 rejection is WITHDRAWN for reasons of record in Applicant's response.

Statutory Double Patenting Rejections

I. The provisional rejection of claims 1, 2, and 14 under 35 USC 101 as claiming the same invention as that of claims 1, 5, and 6 of copending Application No. 10/122,611 is MAINTAINED for reasons of record in the office action mailed 7/25/02, Paper No. 7.

II. The rejection of claims 1 and 46 under 35 USC 101 as claiming the same invention as that of claim 7 of prior US Patent No. 6,200,546 is MAINTAINED for reasons of record in the office action mailed 7/25/02, Paper No. 7.

Obviousness-type Double Patenting Rejections

The rejection of claim 37 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of US Patent No. 6,200,546 is MAINTAINED for reasons of record in the office action mailed 7/25/02, Paper No. 7.

Note: It is duly noted that in the response filed 10/18/02, Paper No. 9, Applicant did not address the statutory double patenting rejections or the obviousness-type double patenting rejection over US Patent No. 6,200,546.

CLAIM OBJECTIONS

3. Claims 3-13, 15-36, 38-45, and 47-52 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

ALLOWABLE CLAIMS

4. Claims 53-61 are allowable over the prior art of record.

COMMENTS/NOTES

5. It should be noted that no prior art has been cited against Applicant's claims. However, Applicant MUST address and overcome the statutory and obviousness-type double patenting rejections. In particular, the claims are distinguished over the prior art of record because the prior art neither anticipates nor renders obvious compositions and

uses thereof wherein a compound comprising a metal, a chelating group, and a gastrin releasing peptide that includes a bombesin agonist moiety are utilized.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (703) 308-4640. The examiner can normally be reached on Mon.-Fri. (alternate Mon.), 6:45 a.m. - 4:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose' Dees can be reached on (703) 308- 4628. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



D. L. Jones
Primary Examiner
Art Unit 1616

January 23, 2003